

35 U.S.C. § 112 Rejections

Claims 39-41 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner indicated that the phrase "and so on up to an N number" is a relative term which renders the claim indefinite. Applicants respectfully disagree with the Examiner's characterization of this phrase. Nonetheless, in an effort to address the Examiner's hesitation regarding this phrasing, claims 39-41 have been amended to more clearly specify that the stent of the invention is comprised of a preselected number N, that is a number that is at the user's discretion, of cylindrical elements. The specification clearly does not limit the stent of the invention to a specific number of such cylindrical elements, and thus there is no reason why the claims should be so limited. Furthermore, and despite the Examiner's opinion to the contrary, Applicants firmly believe that a person skilled in the art would most certainly be able to select the proper number N of cylindrical elements when constructing the stent of the present invention based upon the teaching of the disclosure and the knowledge and experience expected of such a person. Thus, in light of the amendments to claims 39-41, Applicants respectfully request the Examiner to reconsider her position and allow these claims.

35 U.S.C. § 101 Rejections

Claim 1 was rejected under 35 U.S.C. 101 as claiming the same invention as claim 1 of prior U.S. Patent No. 5,514,154. Applicants have canceled claim 1 from the present application.

Furthermore, claims 25-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,514,154. Applicants have filed a Terminal Disclaimer concurrently with the present Response in which the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of U.S. Pat. No. 5,514,154 has been disclaimed. Applicants therefore believe that both double patenting rejections have been overcome.

35 U.S.C. § 103 Rejections

Claims 25 and 33-35 were rejected as being unpatentable over U.S. Pat. No. 5,902,332 to Schatz, which in the Examiner's view discloses a plurality of cylindrical elements which are expandable with at least one weld connection between each cylindrical element (Fig. 7 and col. 10, ll. 3-48) and with circumferential offset members 100. The Examiner admitted that Schatz does not specify welds, but opined that it would have been obvious to one skilled in the art to weld, laser cut, or utilize other methods of metal shaping the connections between cylindrical elements because this is a well known technique in the art of stent making and is a matter of design choice.

Applicants respectfully disagree with the Examiner's reading of this reference and characterization of the state of the art. Erstwhile, Applicants wish to respectfully remind the Examiner of the burden imposed by MPEP 706.02(j) on Patent Examiners when issuing obviousness rejections to set forth in the rejection an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification necessary to arrive at the claimed subject matter. The Applicants submit that there is

no suggestion nor motivation on the part of Schatz for welding connectors between the adjacent tubular members 71, or grafts, or prostheses 70 (col. 10, ll. 8-9) of his invention. The only method disclosed by Schatz for connecting these tubular members is by forming connector members 100 *integrally* between adjacent grafts 70 or tubular members 71 (col. 10, ll. 11-13). The purpose of the connector members 100 of Schatz is to provide flexibility because the grafts 70 are relatively rigid:

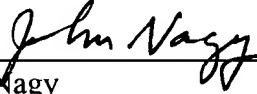
As seen in FIG. 7, graft, or prosthesis, 70 generally includes a plurality of prostheses, or grafts, 70' as described previously in connection with FIGS. 1A, 1B, and 2. Disposed between adjacent tubular members, 71, or adjacent grafts, or prostheses, 70, is a single connector member 100 to flexibly connect adjacent tubular members 71 or grafts, or prostheses, 70. Connector members 100 are preferably formed of the same material as grafts 70, as previously described, and connector members 100 may be formed integrally between adjacent grafts 70, or tubular members 71, as shown in FIG. 7. The cross-sectional configuration of connector members 100, along the longitudinal axis of graft, or prosthesis, 70', is the same, in that connector members 100 have the same uniform wall thickness of elongate members 75 and thus form a thin-walled, elongate bar member 101 which is coplanar with adjacent tubular member 71. Of course, it should be readily apparent to one of ordinary skill in the art, that the thickness of connector members 100 could alternatively be smaller than elongate member 75; however, it is preferable that the outer circumferential surface 102 of connector members 100 lies in the same plane formed by wall surfaces 74 or grafts, or prostheses, 70, as seen in FIG. 7.

(col. 10, ll. 3-25). Thus, there is no suggestion or teaching in Schatz to use welds to connect the adjacent stents. It is well known that welds will reduce flexibility and may be less reliable structurally than the one piece construction taught by Schatz (col. 10, ll. 9-13). Because the purpose of connectors 100 of Schatz is to provide flexibility, to suggest that welds would be an obvious design choice, when welds actually reduce flexibility, is without justification. A person skilled in the art would not weld together the Schatz grafts 70 because doing so would reduce flexibility instead of providing flexibility as taught by Schatz. Applicants therefore respectfully urge the Examiner to remove this rejection and allow the claims.

In view of the foregoing it is respectfully urged that claims 25-42 are in condition for allowance and early consideration is earnestly solicited. The undersigned counsel can be reached at (310) 824-5555 for a telephonic interview or to resolve any matters to facilitate prosecution of the application.

Respectfully submitted,

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